

AF/3623
JRW

Attorney's Docket No. 032264-054



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
R. Michael FAY et al.) Group Art Unit: 3623
Application No.: 09/709,323) Examiner: Susanna M Meinecke Diaz
Filed: November 13, 2000) Confirmation No.: 3508
For: SOUND CONTROL METHOD)

TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

In Response to the Notification of Non-Compliant Appeal Brief mailed September 13, 2005, Appellants submit herewith a Substitute Brief which supplies an Evidence Appendix and a Related Proceedings Appendix as required. Accordingly, the Substitute Brief is in compliance with 37 C.F.R. §41.37.

Respectfully submitted,

BUCHANAN INGERSOLL PC

Date: October 24, 2005

By: George F. Lesmes
George F. Lesmes
Registration No. 19,995

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Buchanan Ingersoll PC
ATTORNEYS

Including attorneys from Burns Doane Swecker & Mathis

(8/05)



Patent
Attorney Docket No.: 032264-054

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application:)
Ralph Michael FAY et al.)
Application No.: 09/709,323) Group: 3623
Filed: November 13, 2000) Examiner: Susanna M. Diaz
Title: SOUND CONTROL METHOD) Conf. No.: 3508

SUBSTITUTE BRIEF FOR APPELLANTS

Attn: Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Notice of Appeal filed May 17, 2005, Applicants file herein this Appeal Brief. This appeal is from the decision of the Examiner dated January 18, 2005, finally rejecting claims 1 - 24, 26 - 37, and 40 - 63. All claims pending in the application, namely claims 1 - 24, 26 - 37, and 40 - 63 are reproduced as an Appendix to this Brief.

The May 17, 2005 filing of the Notice of Appeal provided for a period for filing an Appeal Brief set to expire July 17, 2005. A Petition for a One Month Extension of Time is being submitted herewith, thereby extending the period for filing this Appeal Brief to August 17, 2005. The Commissioner is hereby authorized to charge any appropriate fees that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800.

I. Real Party in Interest

The entire interest in the present application, and the invention to which it is directed, is assigned to JOHNS MANVILLE, a corporation duly organized under and pursuant to the laws of Delaware and having its principal place of business in Denver, Colorado.

II. Related Appeals and Interferences

The Applicants' legal representative or assignee does not know of any other appeals, interferences, or judicial proceedings which are related to, will directly affect, or will be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of the Claims

This application was originally filed November 24, 2000 with claims 1 - 63. Claims 25, 38, and 39 were canceled by an amendment filed September 29, 2004. Therefore, claims 1 - 24, 26 - 37, and 40 - 63 are currently pending in the application. Claims 1 - 24, 26 - 37, and 40 - 63 stand finally rejected under 35 USC §§ 102(a), 103(a). Accordingly, claims 1 - 24, 26 - 37, and 40 - 63 are the subject of the present appeal. A correct copy of all pending claims, comprised of the claims on appeal, is attached as an Appendix to this Brief.

IV. Status of Amendments

An Amendment was filed September 29, 2004 in response to an April 29, 2004 non-final Office Action. A final Office Action was mailed January 18, 2005 rejecting claims 1 - 24, 26 - 37, and 40 - 63. No responses or amendments have been filed in response to the January 18, 2005 Office Action.

V. Summary of the Claimed Subject Matter

Exemplary embodiments of the Applicants' invention, as recited in independent claims 1 and 32, are directed to a computer-implemented system and method for enhancing the performance of a project, wherein the project includes construction or modification of a structure (specification at page 8, lines 10 - 18; page 12, lines 4 - 8). A desired level of performance, such as a certain level of sound control performance as represented by a field sound transmission class or coefficient (FSTC) level, is input to the system along with other project information such as the building plans, building specifications, and materials lists (page 11, line 19 - page 4; page 13, lines 1 - 8). Based on the input project information and the input desired level of acoustical performance, a computer selects acoustical enhancement solutions and modifies the inputted

project information to incorporate the selected enhancement solutions, thereby achieving the desired acoustical performance level for the project (page 13, line 9 - page 14, line 19).

VI. Grounds of Rejection to be Reviewed on Appeal

A. Claims 1 - 5, 12 - 14, 16 - 18, 26, 27, 32, 33, 41 - 45, 47 - 51, 54, 55, 57, 62, and 63 stand rejected under 35 USC § 102(a) as being anticipated by SoundPLAN simulation software, as disclosed in multiple Internet web pages for www.soundplan.com as extracted by the private Internet archive access software, Wayback Machine.

B. Claims 1 - 24, 26 - 37, and 40 - 63 stand rejected under 35 USC § 103(a) as being unpatentable over Higgins, "Don't Just Sit There," (Feb, 1999) and Gornick, "The Quest for Quiet," (Dec, 1997) in view of SoundPLAN simulation software, as disclosed in multiple Internet web pages for www.soundplan.com as extracted by the private Internet archive access software, Wayback Machine.

VII. Argument

A. Claims 1 - 5, 12 - 14, 16 - 18, 26, 27, 32, 33, 41 - 45, 54, 55, 57, 62, and 63 are not Properly Rejected under 35 USC § 102(a) As Being Anticipated by SoundPLAN simulation software, as disclosed in the Wayback Machine archived web pages of www.soundplan.com.

1. Claim 1 is Patentable Over SoundPLAN

Independent claim 1 stands rejected under 35 USC § 102(a) as being anticipated by SoundPLAN simulation software. Under a rejection based on 35 USC § 102(a), the Examiner bears the burden of showing where every limitation in the patent claims is taught in a single prior art reference. *General Electric Co. v. Nintendo Co.*, 50 USPQ2d 1910, 1915, 1918-19 (CAFC 1999); MPEP § 706.2. The Applicant respectfully asserts that SoundPLAN simulation software, contrary to the requirements of 35 USC § 102(a), fails to teach or suggest all of the features recited in claim 1.

Exemplary embodiments of the Applicants' invention, as recited in independent claim 1, are directed to a computer-implemented method for enhancing the performance of a project,

wherein the project includes construction or modification of a structure. In particular, and reciting relevant portions of independent claim 1, exemplary embodiments of Applicants' methodology for enhancing performance of a project include:

inputting project information, including a desired performance level;
selecting, by a computer, enhancement solutions based on the project information; and
modifying the inputted project information to incorporate the selected enhancement solutions.

The SoundPLAN simulation software has been presented in the Office Action as disclosing each and every feature recited in claim 1. The Applicants respectfully submit that the Office Action's reliance on the SoundPLAN software is misplaced. The SoundPLAN simulation software is designed to model and simulate the flow of noise, wind, and pollutants in and around various structures. See SoundPLAN pages 3, 5, 9, 12, 16, and 19. As such, the graphical output of the SoundPLAN software can be used by planners to subsequently plan for quieter, less polluted environments. SoundPLAN at pages 7, 14, and 20. Contrary to the features recited in claim 1, the SoundPLAN software is completely silent regarding the inputting of project information, including a desired performance level, and automatically modifying the inputted project information to incorporate selected enhancement solutions. The Office Action cites to pages 29 and 32 of the SoundPLAN software as allegedly teaching these features. However, a close reading of the cited portions of SoundPLAN discloses that the SoundPLAN system is an optimization system for recommending optimal wall shapes to minimize the size of noise protection walls or building costs. In short, the SoundPLAN system is designed to provide optimal and/or minimal solutions with no provisions for inputting desired performance levels to be achieved or dynamically modifying the input project information, as recited in claim 1.

2. Claim 32 is Patentable Over SoundPLAN

Independent claim 32 stands rejected under 35 USC § 102(a) as being anticipated by SoundPLAN simulation software. Under a rejection based on 35 USC § 102(a), the Examiner

bears the burden of showing where every limitation in the patent claims is taught in a single prior art reference. *General Electric Co. v. Nintendo Co.*, 50 USPQ2d 1910, 1915, 1918-19 (CAFC 1999); MPEP § 706.2. The Applicant respectfully asserts that SoundPLAN simulation software, contrary to the requirements of 35 USC § 102(a), fails to teach or suggest all of the features recited in claim 32.

Independent claim 32 is directed toward a system for enhancing the performance of a project, including:

a central computer for receiving project information;
a control center containing a plurality of enhancement solutions; and
a reviewer for determining a combination of enhancement solutions based on the received project information, wherein the reviewer is a reviewing computer.

As discussed above regarding claim 1, SoundPLAN is directed toward providing graphical images of noise, wind, and pollutant flow and suggesting optimal solutions to minimize wall size and building costs. Nowhere does SoundPLAN disclose determining, by a computer, a combination of enhancement solutions based on the received project information. Instead, SoundPLAN merely attempts to optimize, or minimize, building components and costs, regardless of specific enhancement solutions that have been provided for a particular project.

3. Claims 2 - 5, 12 - 14, 16 - 18, 26, 27, 33, 41 - 45, 54, 55, 57, 62, and 63 are Patentable Over SoundPLAN

Claims 2 - 5, 12 - 14, 16 - 18, 26, 27 depend from claim 1 and include all the features of claim 1 plus additional features which are not taught or suggested by SoundPLAN. Claims 33, 41 - 45, 54, 55, 57, 62, and 63 depend from claim 32 and include all the features of claim 32 plus additional features which are not taught or suggested by SoundPLAN.

Dependent claim 2 - 5, 12 - 14, 16 - 18, 26, 27, 33, 41 - 45, 54, 55, 57, 62, and 63 stand rejected under 35 USC § 102(a) as being anticipated by SoundPLAN simulation software. Under a rejection based on 35 USC § 102(a), the Examiner bears the burden of showing where

every limitation in the patent claims is taught in a single prior art reference. *General Electric Co. v. Nintendo Co.*, 50 USPQ2d 1910, 1915, 1918-19 (CAFC 1999); MPEP § 706.2. However, the Office Action has presented no analysis regarding where the SoundPLAN system discloses the features recited in these claims, contrary to the requirements of 37 CFR §1.104(c) and MPEP §706. Instead, the Office Action merely asserts on pages 4 - 5 that SoundPLAN discloses four features rather than all of the elements recited in these 23 claims. In fact, the Office Action fails to address any of these claims in its rejection under 35 USC §102 other than to broadly assert that the SoundPLAN software discloses a noise evaluation module, an interactive module for entering project information, calculates the sound transmission class for windows, and outputs a recommended optimum wall shape..

It is respectfully submitted that SoundPLAN fails to disclose each of the features recited in claims 1 - 5, 12 - 14, 16 - 18, 26, 27, 32, 33, 41 - 45, 54, 55, 57, 62, and 63 as required under 35 USC § 102(a); and, therefore, SoundPLAN cannot reasonably be said to anticipate Applicants' claimed invention. Accordingly, claims 1 - 5, 12 - 14, 16 - 18, 26, 27, 32, 33, 41 - 45, 54, 55, 57, 62, and 63 are believed to be patentably distinguishable over the SoundPLAN system as disclosed in the WayBack Machine documents, and it is respectfully requested that the rejection of claims 1 - 5, 12 - 14, 16 - 18, 26, 27, 32, 33, 41 - 45, 54, 55, 57, 62, and 63 under 35 USC § 102(a) be reversed.

B. Claims 1 - 24, 26 - 37, and 40 - 63 are not Properly Rejected Under 35 USC § 103(a) as Being Obvious Over Higgins, "Don't Just Sit There," (Feb 1999) and Gornick, "The Quest for Quiet," (Dec 1997) in view of the SoundPLAN simulation software, as disclosed in the Wayback Machine archived web pages of www.soundplan.com.

1. Claim 1 is Patentable Over Higgins and Gornick in view of SoundPLAN.

Independent claim 1 stands rejected under 35 USC § 103(a) as being unpatentable over Higgins, "Don't Just Sit There," (Feb 1999) and Gornick, "The Quest for Quiet," (Dec 1997) in view of the SoundPLAN system. Under a rejection based on 35 USC § 103(a), the Examiner bears the burden of showing a *prima facie* case of obviousness based upon the prior art. *In re*

Roufett, 47 USPQ2d 1453, 1455 (Fed. Cir. 1998); *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); MPEP § 2142. To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580, 582 (CCPA 1974); MPEP § 2143.03. In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. *In re Roufett* at 1455.

The combination of Higgins, Gornick, and SoundPLAN fails to disclose or suggest all the elements of claim 1. Exemplary embodiments of the Applicants' invention, as recited in independent claim 1, are directed to a computer-implemented method for enhancing the performance of a project, wherein the project includes construction or modification of a structure. In particular, and reciting relevant portions of independent claim 1, exemplary embodiments of Applicants' methodology for enhancing performance of a project include:

inputting project information, including a desired performance level;
selecting, by a computer, enhancement solutions based on the project information; and
modifying the inputted project information to incorporate the selected enhancement solutions.

The Higgins reference has been presented on page 6 of the Office Action as the primary reference for allegedly disclosing the features recited in claim 1. Higgins is a 1999 article discussing the development of office furniture and electronic equipment for the new millennium. A portion of the article on its third page discusses how the acoustical testing services offered at Johns Manville's Denver, Colorado testing laboratory has resulted in lower-cost office panels without sacrificing structure (Higgins at ¶¶ 23, 26). Office panel manufacturers, including Herman Miller, bring their panels to the laboratory, where they are tested for sound transmission coefficients and noise reduction coefficients (¶¶ 23 - 25). A focus of the testing is how to eliminate some of the structural members of the panels, thereby reducing their cost, without giving up acoustics or structural requirements (¶¶ 23, 26). Based on the tests, Herman Miller redesigned the panels, thereby reducing their cost (¶¶ 27, 28).

The Applicants respectfully assert that the Office Action's reliance on Higgins is misplaced because Higgins fails to teach all of the features recited in independent claim 1. The inventive method of claim 1 begins with the inputting of project information, with project information including, for example, building plans, project specifications, and materials lists. Importantly, the input information also includes a performance level that is desired for the project to achieve. In some embodiments of the application, the desired performance level is a particular field sound transmission class or coefficient. The Office Action cites to Higgins at ¶¶ 24 and 26 as disclosing this feature. However, a close reading of Higgins shows that there is no predetermined cost or acoustical performance level established for the office panels to achieve as a result of the testing. In fact, Higgins is completely silent regarding the threshold step of inputting project information. In Higgins, Herman Miller merely wanted to generally "improve the value of its free-standing panels" and did so by first testing the performance of the panels (¶¶ 24, 25). In contrast, the present claimed invention starts with a specific performance level and automatically modifies the input project information with selected enhancement solutions to meet the input, predetermined performance level of the entire project, such as a building. Also, Higgins is limited to a laboratory environment where individual components, such as office panels and furnace motors, not an entire project as claimed herein, are tested for their acoustical performance.

Claim 1 further recites that, based on the input project information, including the desired level of acoustical performance, a computer selects enhancement solutions and modifies the inputted project information to incorporate the selected enhancement solutions, thereby achieving the desired acoustical performance level for the project. In contrast, the result of the testing in Higgins, after six months time and a redesign of the panel by Herman Miller and not Johns Manville, is an office panel with less steel and more hardboard, thereby reducing its cost (¶¶ 27, 28). Higgins discloses that the result of the testing process was a reduction in the cost of the office panel without negatively impacting the acoustical performance of the office panel (see ¶¶ 24, 26).

No input project information is identified in Higgins; and, accordingly, Higgins also fails to disclose any input project information being modified to incorporate the selected enhancement

solutions. The Office Action cites to ¶¶ 26 - 28 of Higgins as allegedly disclosing this feature. However, Higgins discloses a six month redesign process undertaken by Herman Miller before any improvement could be realized. If the Johns Manville testing services discussed in the Higgins article rendered obvious the invention recited in claim 1, then the testing services would directly modify the input project information to incorporate selected enhancement solutions -- not revert to a six-month redesign effort by Herman Miller personnel.

The Office Action admits that Higgins fails to disclose selecting enhancement solutions by a computer and, consequently, introduces the SoundPLAN simulation software on page 8 to combine with the Higgins reference to allegedly disclose the computer-implemented method recited in claim 1. However, while the SoundPLAN system may be executable on a computer, this simulation and modeling system fails to remedy the deficiencies of the Higgins article.

It is respectfully submitted that the Higgins article and the SoundPLAN system, whether alone or in combination, fail to disclose each of the features recited in independent claim 1; and, therefore, the Higgins/SoundPLAN combination cannot reasonably be said to render Applicants' claimed invention obvious. In summary, the Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness against claim 1. More specifically, the Examiner has not shown how or where the prior art teaches or suggests all the claimed limitations. As discussed above, even the combination of the references fails to teach all the features recited in claim 1.

2. Claim 32 is Patentable Over Higgins and Gornick in view of SoundPLAN.

Independent claim 32 stands rejected under 35 USC § 103(a) as being unpatentable over Higgins, "Don't Just Sit There," (Feb 1999) and Gornick, "The Quest for Quiet," (Dec 1997) in view of the SoundPLAN system. Under a rejection based on 35 USC § 103(a), the Examiner bears the burden of showing a *prima facie* case of obviousness based upon the prior art. *In re Roufett*, 47 USPQ2d 1453, 1455 (Fed. Cir. 1998); *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); MPEP § 2142. To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580, 582 (CCPA 1974); MPEP § 2143.03. In the absence of a proper *prima facie* case of

obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. *In re Roufett* at 1455.

The combination of Higgins, Gornick, and SoundPLAN fails to disclose or suggest all the elements of claim 32. Independent claim 32 is directed toward a system for enhancing the performance of a project, including:

a central computer for receiving project information;
a control center containing a plurality of enhancement solutions; and
a reviewer for determining a combination of enhancement solutions based on the received project information, wherein the reviewer is a reviewing computer.

The Office Action on page 15 broadly asserts that claim 32 is rejected under the same reasoning as presented for claim 1. However, claim 32 recites “a reviewer for determining a combination of enhancement solutions based on the received project information, wherein the reviewing is a reviewing computer,” a feature which is neither recited in claim 1 nor disclosed in either Higgins or SoundPLAN.

It is respectfully submitted that the Higgins article and the SoundPLAN system, whether alone or in combination, fail to disclose each of the features recited in independent claim 32; and, therefore, the Higgins/SoundPLAN combination cannot reasonably be said to render Applicants' claimed invention obvious. In summary, the Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness against claim 32. More specifically, the Examiner has not shown how or where the prior art teaches or suggests all the limitations recited in claim 32.

3. Claims 2 - 24, 26 - 31, 33 - 37, and 40 - 63 are Patentable Over Higgins and Gornick in view of SoundPLAN.

Dependent claims 2 - 24, 26 - 31, 33 - 37, and 40 - 63 stand rejected under 35 USC § 103(a) as being unpatentable over Higgins, “Don’t Just Sit There,” (Feb 1999) and Gornick, “The Quest for Quiet,” (Dec 1997) in view of the SoundPLAN system. Under a rejection based

on 35 USC § 103(a), the Examiner bears the burden of showing a *prima facie* case of obviousness based upon the prior art. *In re Roufett*, 47 USPQ2d 1453, 1455 (Fed. Cir. 1998); *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); MPEP § 2142. To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580, 582 (CCPA 1974); MPEP § 2143.03. In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. *In re Roufett* at 1455.

Claims 2 - 24 and 26 - 31 depend from claim 1 and include all the features of claim 1 plus additional features which are not taught or suggested by the Higgins, Gornick, and SoundPLAN references. Claims 33 - 37, and 40 - 63 depend from claim 32 and include all the features of claim 32 plus additional features which are not taught or suggested by the Higgins, Gornick, and SoundPLAN references.

The Office Action, on pages 6 - 8, relies primarily on Higgins to reject each of the features recited in claims 2 - 13, 26 - 27, 60, and 63. The Applicants respectfully disagree that Higgins renders obvious the features recited in claims 2 - 13, 26 - 27, 60, and 63. For example, claims 2, 3, and 5 specify that the project information includes building plans for a structure; information on the uses of rooms within the structure; and information on the areas within the structure, wherein the desired performance level is a performance of noise reduction between the areas. None of these features are taught or even suggested by Higgins, Gornick, or SoundPLAN. The Office Action cites to Higgins at ¶¶ 23 - 28 as allegedly disclosing these features. However, contrary to the assertions of the Office Action, Higgins is completely silent regarding any building plans for a structure or the uses of rooms within a structure. Whether Herman Miller's office panels can be used in a building's rooms, as asserted in the Office Action, is not a substitute for the failure of the Higgins article to disclose project information that includes the uses of rooms within a building structure. Higgins is clearly limited to the testing of office panels and is silent regarding the uses of rooms of a building structure as input project information.

The Office Action further cites to the combination of Higgins at ¶¶ 24, 25, and 28 and Gornick at ¶41 as disclosing the features recited in claim 5 that the desired performance level is a

performance of noise reduction between the areas within a structure. Gornick is a 1997 article discussing Johns Manville's Littleton, Colorado acoustical testing laboratory, which is noted as being recently expanded to now be able to test sound power output of appliances and to be able to conduct three-dimensional sound intensity testing (Gornick at ¶¶ 41, 42). The laboratory includes facilities to test the components of appliances, including furnaces (¶¶ 45, 46). In this manner, the engineers can listen to the furnace in actual operation and then evaluate ways to reduce the sound level (¶ 46).

Neither Higgins nor Gornick disclose that the desired performance level is a performance of noise reduction between the areas. As discussed above, the only performance level Higgins is concerned with improving is the cost of the office panels. Gornick discloses sound testing of appliances and furnaces, including motors and blowers (Gornick at ¶¶ 41, 44, and 45), with no mention of noise reduction between areas within a structure. Therefore, for at least this reason and the reasons set forth above with respect to claims 1 and 32, it is submitted that claims 2 - 13, 26 - 27, 60, and 63 patentably distinguish over the Higgins or Gornick documents.

The Office Action admits on pages 9 - 18 that the features recited in claims 14 - 24, 28 - 32, 40, 41, 43, 61, and 62 are not disclosed in the art of record. However, rather than allowing these claims, the Office Action takes Official Notice, without support, that the features recited in each of these claims are old and well known and that it would have been obvious to enhance Johns Manville's consulting services with these recited features. In the prior, September 29, 2004 amendment, the Applicants requested, pursuant to MPEP § 2144.03, the Examiner provide a reference that teaches each of the features recited in these claims. No such information was provided in the present, final Office Action, where the rejection of claims 14 - 24, 28 - 32, 40, 41, 43, 61, and 62 continues to rely solely on the Examiner's taking Official Notice and unsupported assertions of obviousness.

The Applicants respectfully note the Office Action has relied on Higgins, Gornick, and SoundPLAN to reject claims 33 - 37, 42, 44 - 49, and 52 - 59 under 35 U.S.C. §103, but has presented no analysis regarding where each of these documents discloses the features recited in these claims, contrary to the requirements of 37 CFR §1.104(c) and MPEP §706. In fact, the Office Action fails to address any of these claims in its rejection under 35 USC §103. The

Office Action does assert, without explanation or citation, on page 15 that claims 32 - 37 and 40 - 59 recite limitations already addressed by the rejection of claims 1 - 24, 26 - 31 and 60 - 63 above and that, therefore, the same rejection applies to these claims. However, the Office Action fails to assert any alleged mapping between the 26 claims of claims 32 - 37 and 40 - 59 and the 34 claims of claims 1 - 24, 26 - 31 & 60 - 63. Accordingly, the Applicants are not aware of the particular parts of Higgins, Gornick, and SoundPLAN, if any, the Office Action is relying on for the rejection of claims 32 - 37 and 40 - 59; and, therefore, the Applicants are unable to specifically respond as to why the rejection of claims 33 - 37, 42, 44 - 49, and 52 - 59 may not be proper.

In view of the wholesale use of “Official Notice” and unsupported assertions of obviousness, the rejection of the Office Action has done little more than use the disclosure and claims herein as a template for the rejection rather than citing any prior art that discloses or suggests the features recited in claims 1 - 24, 26 - 37, and 40 - 63. The Examiner cannot arrive at a determination of obviousness by using the claimed invention as a template to piece together prior teachings in an attempt to render the invention obvious, which is the essence of impermissible hindsight. *In re Dembiczaik*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Claims 50 and 51 recite that at least one of the enhancement solutions includes information on a sound absorbing material or a sound blocking material. Higgins and Gornick are completely silent regarding any such information. While Higgins discloses Johns Manville being a provider of fiberglass insulation at ¶ 23 and discloses hardboard panels and steel being structural materials at ¶¶ 26, 27, this reference is completely silent regarding any information on a sound absorbing material or a sound blocking material; nor does Higgins disclose information on these materials comprising an enhancement solution, as recited in claims 50 and 51, as depending from claim 49.

4. With Respect to Claims 1 - 24, 26 - 37, and 40 - 63, the Office Action has not Established a *prima facie* Case of Obviousness Because the Office Action Fails to Show an Objective Teaching or Knowledge in the Art That Would Have

Motivated a Person of Ordinary Skill in the Art to Combine the Higgins, Gornick, and SoundPLAN References in the Manner Suggested by the Office Action.

For a conclusion of obviousness based on a combination of references to be proper, there must be a reason, suggestion, or motivation to make the combination. *In re Rouffet* at 1456; *In re Fritch* at 1783; *In re Fine*, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); MPEP § 2143.01. Specifically, the court has stated that to establish a *prima facie* case of obviousness the PTO must, among other things, “[show] some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine* at 1598. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Rouffet* at 1456-58; *In re Mills*, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990); MPEP § 2143.01.

The U.S. Court of Appeals for the Federal Circuit has identified three possible sources for a motivation to combine references: the nature of the problem to be solved, the knowledge of persons of ordinary skill in the art, and the teachings of the prior art. *In re Rouffet* at 1458; *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996). In the present case, with respect to rejected claims 1 - 24, 26 - 37, and 40 - 63, the Office Action has relied on none of these reasons as a basis for combining Higgins, Gornick, and SoundPLAN to allegedly render the claims obvious.

The Office Action admits on pages 8 - 9 that Higgins does not expressly teach that the step of “selecting enhancement solutions based on the project information” is performed by a computer. The Office Action then introduces SoundPLAN for purposes of rendering obvious the use of a computer in the acoustical testing services disclosed by Higgins. The Office Action asserts on page 9 that “[c]learly, SoundPLAN is capable of automatically performing the types of acoustical testing services manually performed by Johns Manville;” and, therefore it would have been obvious to modify Higgins with the computer of SoundPLAN. However, nothing in the Higgins article indicates any deficiency that would be addressed by the computer of SoundPLAN. Accordingly, there is no suggestion or motivation in either reference to add the

computer of SoundPLAN to the acoustical testing services of Higgins in the manner suggested by the Office Action.

Further, the Office Action purports to present the archived web pages from the www.soundplan.com site as a single, prior art reference. However, there has been no evidence or showing made that the 39 pages presented as the SoundPLAN “reference” were in fact published on the same date and that the publication date was prior to the November 24, 2000 filing date of the present application. In fact, the Wayback Machine cover page to the SoundPLAN document shows that the majority of the retrieved www.soundplan.com documents actually have dates which are later than the November 24, 2000 filing date and, accordingly cannot be considered prior art to the present application under 35 USC §§ 102 or 103. Additionally, there has been no showing that the Wayback Machine has actually been tested and validated as being able to consistently determine the publication date of an Internet web page. Nor has there been a showing that the authors of the WayBack Machine designed this archive product to determine the publishing date of web pages and to be used to locate invalidating art under 35 USC §§ 102 and 103. Under MPEP § 2128, if a publication does not have a publication date, it cannot be relied upon as prior art. Only page 4 of the SoundPLAN documents has a publication date, and the remaining pages carry no indication when they were individually published.

In summary, the Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness against claims 1 - 24, 26 - 37, and 40 - 63. More specifically, the Examiner has not shown how or where the prior art teaches or suggests all the claimed limitations. As discussed above, even the combination of the references fails to teach all the features recited in claims 1 - 24, 26 - 37, and 40 - 63. Accordingly, the Applicants respectfully request the rejection of claims 1 - 24, 26 - 37, and 40 - 63 be reversed.

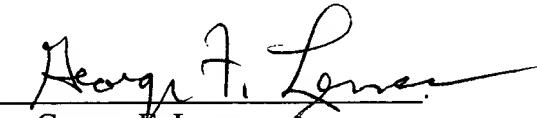
Conclusion

In summary, the Applicant respectfully submits that the Examiner has failed to show where the Higgins, Gornick, and SoundPLAN references cited under 35 USC §§ 102(a), 103(a), either alone or in any combination, anticipate or render obvious each of the features recited in

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Application No. 09/709,323

claims 1 - 24, 26 - 37, and 40 - 63. More specifically, the Examiner has not shown how or where the prior art teaches or suggests all the claimed limitations. Accordingly, the Applicant respectfully requests the rejection of claims 1 - 24, 26 - 37, and 40 - 63 be reversed.

Respectfully submitted,
Johns Manville Corporation

By: 
George F. Lesmes
Registration No.: 19,995

P.O. Box 1404
Alexandria, Virginia 22314-0404
Telephone: (703) 836-6620
Facsimile: (703) 836-2021

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VIII. Claims Appendix

All Pending Claims, Including The Claims Under Appeal,
Namely Claims 1 - 24, 26 - 37, and 40 - 63

1. (Previously Presented) A computer-implemented method for enhancing performance of a project, comprising the steps of:
 inputting project information, including a desired performance level;
 selecting, by a computer, enhancement solutions based on the project information; and
 modifying the inputted project information to incorporate the selected enhancement solutions.
2. (Original) The method of claim 1, wherein the project information comprises building plans for a structure.
3. (Original) The method of claim 2, wherein the project information comprises information on the uses of rooms within the structure.
4. (Original) The method of claim 2, wherein the project information comprises information on interior structural elements.
5. (Original) The method of claim 1, wherein project information comprises information on areas within a structure, and wherein the desired performance level is a performance of noise reduction between the areas.
6. (Original) The method of claim 1, wherein the enhancement solutions are selected from a plurality of enhancement solutions stored in a sound control center.
7. (Original) The method of claim 6, wherein each enhancement solution is combinable with another enhancement solution to form a combination of enhancement solutions.

8. (Original) The method of claim 7, wherein a system performance rating is associated with each combination of enhancement solutions, and wherein each system performance rating is stored in the sound control center.
9. (Original) The method of claim 8, wherein each system performance rating is a field sound transmission class rating.
10. (Original) The method of claim 8, wherein the step of selecting further comprises the step of choosing a combination of enhancement solutions with a system performance rating equal to or greater than the desired performance level.
11. (Original) The method of claim 10, wherein a cost is associated with each combination of enhancement solutions and wherein the combination of enhancement solutions is also chosen based on cost.
12. (Original) The method of claim 2, wherein the step of selecting further comprises the step of reviewing the project information to determine improvement areas.
13. (Original) The method of claim 12, wherein the enhancement solutions are selected based upon the determined improvement areas.
14. (Original) The method of claim 13, wherein the determined improvement areas include acoustical weak links.
15. (Original) The method of claim 14, wherein the weak links include penetrating items, construction discontinuities, sound transmission through structural components, and cross-talk through ducts.

16. (Original) The method of claim 13, wherein at least one of the enhancement solutions involves the addition of a sound control component.
17. (Original) The method of claim 16, wherein the sound control component is a sound control material installed in a wall, floor, or ceiling assembly.
18. (Original) The method of claim 16, wherein the sound control component is a material for sealing wall, floor, and ceiling perimeters.
19. (Original) The method of claim 16, wherein the sound control component is an acoustically enhanced door.
20. (Original) The method of claim 13, where at least one of the enhancement solutions involves the indirect positioning of interior components.
21. (Original) The method of claim 20, wherein the interior components comprise electrical outlets, air ducts, and fluid-filled pipes.
22. (Original) The method of claim 13, wherein at least one of the enhancement solutions involves the discontinuous construction of structural elements of the project.
23. (Original) The method of claim 22, wherein the at least one enhancement solution comprises the staggering of wall studs.
24. (Original) The method of claim 22, wherein the at least one enhancement solution comprises the addition of a cut line in a floor or floor elements.
25. (Canceled)

26. (Previously Presented) The method of claim 1, wherein the modified inputted information describes a project operating at the desired performance level.
27. (Previously Presented) The method of claim 25 1, further comprising the step of presenting the modified project information to a user.
28. (Original) The method of claim 27, wherein the modified project information is transferred from the sound control center to a remote computer.
29. (Previously Presented) The method of claim 1, wherein the modified project information includes a bill of materials.
30. (Original) The method of claim 29, wherein the bill of materials includes cost information.
31. (Original) The method of claim 30, wherein the modified project information includes of a list of tasks based on the selected enhancement solutions.
32. (Previously Presented) A system for enhancing performance of a project, the system comprising:
 - a central computer for receiving project information;
 - a control center containing a plurality of enhancement solutions; and
 - a reviewer for determining a combination of enhancement solutions based on the received project information, wherein the reviewer is a reviewing computer.
33. (Original) The system of claim 32, wherein each enhancement solution is combinable with at least one other enhancement solution to form a combination of enhancement solutions.

34. (Original) The system of claim 32, wherein the central computer is located in a design department.
35. (Original) The system of claim 34, wherein the design department is located in the control center.
36. (Original) The system of claim 34, wherein the design department is located in a main facility.
37. (Original) The system of claim 32, wherein the reviewer is located in the control center.
38. (Canceled)
39. (Canceled)
40. (Original) The system of claim 32, wherein the project information is transmitted to the central computer through a network from a user computer.
41. (Original) The system of claim 32, wherein the project information comprises building plans for a residential structure.
42. (Original) The system of claim 41, wherein the building plans comprise information on interior structural elements.
43. (Original) The system of claim 41, wherein the project information comprises information on the uses of rooms with the residential structure.
44. (Original) The system of claim 32, wherein the project information comprises a desired performance level.

45. (Original) The system of claim 33, wherein a system performance rating is associated with each combination of enhancement solutions.

46. (Original) The system of claim 45, wherein an acoustical laboratory located in the main facility determines each system performance rating.

47. (Original) The system of claim 45, wherein each system performance rating is a field sound transmission class rating.

48. (Original) The system of claim 45, wherein the review determines a combination of enhancement solutions based on its associated system performance rating.

49. (Original) The system of claim 32, wherein at least one of the plurality of enhancement solutions comprises material information.

50. (Original) The system of claim 49, wherein material information comprises information on a sound absorbing material.

51. (Original) The system of claim 49, wherein material information comprises information on a sound blocking material.

52. (Original) The system of claim 32, wherein at least one of the plurality of enhancement options comprises structural relocation information.

53. (Original) The system of claim 52, wherein structural relocation information contains information on indirectly positioning interior components.

54. (Original) The system of claim 33, wherein each of the combination of enhancement solutions comprises cost information.
55. (Original) The system of claim 54, wherein the reviewer determines a combination of enhancement solutions based on cost information.
56. (Original) The system of claim 32, further comprising partner computers, wherein each partner computer is remotely located from the sound control center and transmits updated material and cost information to the sound control center.
57. (Original) The system of claim 32, wherein the project information is modified to incorporate the determined enhancement solutions.
58. (Original) The system of claim 40, wherein the modified project information is presented at a user computer.
59. (Original) The system of claim 58, wherein the modified project information includes a bill of materials and component installation instructions.
60. (Original) The method of claim 8, wherein each system performance rating is verified by experimentation.
61. (Original) The method of claim 11, wherein each cost includes information related to materials cost and labor cost.
62. (Original) The method of claim 14, wherein the weak links include components having component performance ratings less than the desired performance level.

63. (Original) The method of claim 5, wherein the desired performance level is a field system sound transmission rating.

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EVIDENCE APPENDIX

NONE

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RELATED PROCEEDINGS APPENDIX

NONE